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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,389	07/12/2001	Stephanie K. Clendennen	54257-8029.US00	1613

22918 7590 07/29/2003

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

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DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,389

Applicant(s)

CLENDENNEN ET AL.

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21-23 is/are allowed.
- 6) ☐ Claim(s) 24-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Amendment filed April 28, 2003, paper no.10, has been entered.

Claims 1-12 and 14 are cancelled.

Claims 21-32 are newly added.

Claims 21-32 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

### ***Claim Objections***

Claims 26, 28 and 31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Amendment of the claims to insert --any one of-- before "claim" would obviate this objection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 26-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 and dependents are indefinite in the recitation in claim 21 of "protein comprising the nucleotide sequence" which is confusing and incorrect. Insertion of "--, said nucleic acid--" after "protein" in line 2 of claim 21 would obviate this rejection.

Claims 24-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid of SEQ ID NO:1, a nucleic acid encoding SEQ ID NO:2, and the fragment of SEQ ID NO:1 exemplified in the vector pAG4225, as well as for plant expression vectors, plant cells and plants comprising said nucleic acids, does not reasonably provide enablement for other nucleic acid sequences or for plant expression vectors, plant cells and plants comprising said other nucleic acid sequences, for the reasons of record set forth for claims 1-12 and 14 in the office action mailed December 27, 2002.

Applicant's arguments filed April 28, 2003, have been fully considered but they are not persuasive.

In response to the issue of which nucleotides of 1440-1444 constitutes nucleotide A, which is the remaining unresolved enablement issue, Applicant points to page 15, line 23, as disclosing A as any one of nucleotides 1440-1444, and nucleotides 1440-1443 as representing a start codon (reply page 5).

The Examiner maintains that merely reciting in the specification and claims that "A is any one of nucleotides 1440-1444" does not shed light on the issue of which of nucleotides of 1440-1444 would be enabled as nucleotide A of SEQ ID NO:1. Furthermore, the Examiner finds no reference at page 15 with respect to nucleotides 1440-1443 representing a start codon, and it is unclear how the four nucleotides 1440-1443 of SEQ ID NO:1 could represent a start codon, as

Art Unit: 1638

codons are represented by three nucleotides. Furthermore, even if nucleotides 1440-1443 did represent a start codon, the presence of all four nucleotides would be required in order for the corresponding amino acid to be inserted at the start of the polypeptide, as each nucleotide of a codon must physically interact with each nucleotide of the anticodon of the corresponding tRNA. The specification at page 33 does disclose the construct pAG4225 as containing the kinase domain of SEQ ID NO:2 and as having the sequence presented as nucleotides A-3286 of SEQ ID NO:1, wherein A is any one of nucleotides 1440-1444 (lines 26-28). However, this disclosure also does not shed light on the issue of which of nucleotides of 1440-1444 would be enabled as nucleotide A of SEQ ID NO:1. First, a single construct such as pAG4225 would have only one of nucleotides 1440-1444 as nucleotide A, not any of nucleotides 1440-1444, as a single construct is a single polynucleotide species of a fixed and defined sequence. Second, in order for a polynucleotide encoding the kinase domain of SEQ ID NO:2 to express a functional kinase domain, it would be necessary to maintain the reading frame corresponding to the full length polypeptide of SEQ ID NO:2, and varying the initial nucleotide of the start codon would change the reading frame. Accordingly, an isolated nucleic acid comprising nucleotides A-3286 of SEQ ID NO:1 wherein A is any one of nucleotides 1440-1444 is not enabled.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1638

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Remarks***

Claims 22-23 are allowed.

Claims 21 and 24-32 are rejected.

Claims 21 and 24-32 are deemed free of the prior art given the failure of the prior art to teach or suggest an isolated nucleic acid comprising nucleotides A-3286 of SEQ ID NO:1 wherein A is any one of nucleotides 1440-1444.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

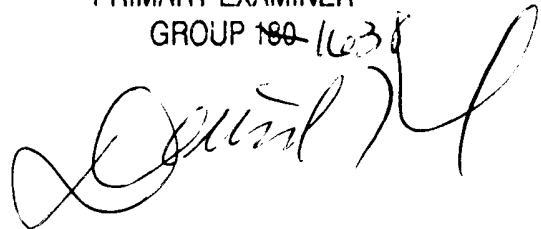
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Art Unit: 1638

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
July 18, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the printed name and title.